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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,722	02/13/2001	Harry E. Gruber		9420

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FOLEY & LARDNER LLP
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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/782,722	GRUBER ET AL.	
	Examiner	Art Unit	
	Siegfried E. Chencinski	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 42 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 42 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 4-19, 42 and 46 are rejected** under 35 U.S.C. 103(a) as being unpatentable over "INTERNET ARCHIVE WAYBACKMACHINE" @ "www.archive.org/web/web.php " Searched for "igive.com" and selected 14 web pages created in Nov 10, 2000 by "igive.com" and hereafter reference "igive.com" , in view of Ziarno (US Patent 5,663,547).

With regard to claim 1, igive.com teaches a method for soliciting charitable donation, the method comprising the steps of:

- hosting a website having information about a fundraising campaign, or an organization (SEE igive.com page #2 " **What if?...up to 12% of each purchase you made went to a worthy cause close to home?** * add your favorite cause to our list * or **choose from 12180 already listed ... Its Working!** * \$776,875.89 raised for causes. * \$278,353.36 raised for causes just this year! * View the list of checks sent to causes),
- providing one or more electronic catalogs, listing one or more items or events that are available for purchase by online shoppers through the website (SEE igive.com page #3 "mall directory" and page #13 "Cooking & Cookware" ... Cooking.com - Cookware, cookbooks, tools, cutlery - - everything for the home chef... Chefs Catalog.com –The leading **catalog** retailer of high-end, top-quality kitchenware for professional and home chefs alike);
- receiving an order from an online shopper purchasing one or more selected items; and

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- providing one or more suggestions on the amount of donation, the suggestions being based on the order from the online shopper (An order is implicit.) and **intended** to encourage and motivate a shopper to make a donation (SEE igive.com page #2 " **What if?**... up to 12% of each purchase you made went to a worthy cause close to home? **"Its Working!** * \$776,875.89 raised for causes. * \$278,353.36 raised for causes just this year! * View the list of checks sent to causes" and further SEE page #5 "Good News You Can Use" . . . "WALNUT AVENUE WOMEN'S CENTER (Santa Cruz, CA) "WE buy groceries to feed the battered women and their children who seek shelter and safety at our center. **We need and appreciate your continued support"** –Jennifer Obrien"). (Applicant's insertion of the phrase "the suggestions being based on the order from the online shopper" by amendment does not change the limitations of this claim element since an order from the online shopper was already provided as context for this claim.).

It was well known at the time of Applicant's invention that many charitable donations had been soliciting by presenting suggested giving amounts, the dollar level depending on the context. For example, many organizations have been making online and mail solicitations by presenting several donation amounts to the prospective donor, such as \$10, \$ 25, \$ 35, \$ 50, \$ 100 or other \$ For known high income or high net worth prospects, the suggested amounts have been in the thousands or even millions of dollars, especially in the case of major capital campaigns. Ziarno discloses electronically providing suggestions of varying donation amounts (Col. 24, ll. 31 – Col. 25, l. 2). In this case, Ziarno teaches the suggestion of three suggested amounts in higher or lower dollar levels according to the perceived or suggested credit status or affluence of the credit card holder (VISA Gold ® vs. VISA CLASSIC ®). Therefore, it would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to combine the disclosures of igive.com with those of Ziarno in order to provide a method for soliciting online charitable donations which includes the suggestion to the prospective donor of one or more donation amounts, motivated by a desire to provide an apparatus and method that allows a fund-raising organization or gift recipient to capture

the impulse of a contributor or gift giver to make a contribution or gift commitment and consummate a contribution or gift prior to the dissipation of the impulse of the contributor or gift giver to make the contribution or gift commitment (Ziarno, Col. 1, ll. 57-63).

With regard to claims 4-6, neither igive.com nor Ziarno illustrate the method step of providing information about the amount of money the fundraising campaign intends to raise and the plans regarding the amount raised and further comprising the step of suggesting a donation amount that will allow the charity to reach its goals further comprising the step of providing information about the average amount of donation from prior donors. However examiner declares OFFICIAL NOTICE that such routine information was commonly provided by the charity to the donor and as a means educating the donor of the cause and extent of need as a means of motivating the donor to give the right amount.

With regard to claims 7 and 8, neither igive.com nor Ziarno illustrate the method step of providing reviews written by prior donors about the charitable causes and their donations and allowing donors to write reviews about the charitable cause and their donation. However examiner declares OFFICIAL NOTICE that such reviews were commonly done and requested by charity as a means of educating the donor of the cause and extent of need as a means of motivating the donor to give the right amount.

With regard to claim 9, igive.com teaches the method step of identifying the geographic location of a donor (during the registration process it is inherent that the donor provides his home address for billing and delivery and the home address given has an inherently known geographic location).

With regard to claim 10, igive.com teaches the method step of providing information about charitable activities in the donor's location (SEE igive.com page #5 "Good News You Can Use" . . . "WALNUT AVENUE WOMEN'S CENTER (**Santa Cruz, CA**) "WE buy groceries to feed the battered women and their children who seek shelter and safety at our center. We need and appreciate your continued support" — Jennifer Obrien" wherein all the people living in Santa Cruz will like hearing about

this).

With regard to claims 11 and 12, igive.com teaches the method step of providing a record of the donor's prior donation history and donor's prior donation amount (SEE igive.com page # 10 "As a member, you have access to timely reports of your earnings and all funds distributed to your cause").

With regard to claim 13, igive.com discloses the step of suggesting a donation amount that is a predetermined percentage of the total amount of purchase (SEE igive.com page 13 "10.0 % for your cause")

With regard to claim 14, igive.com discloses the method step of providing information about the amount of donation made by the donor's friends, family or co-workers (It is inherent that all people are provided the same level of service at igive.com).

With regard to claims 15-17, igive.com discloses a method wherein the organization is a charitable organization, a political action committee or a political organization (SEE igive.com page # 2 * add your favorite cause to our list page 4 * you can list **ANY cause**, large or small).

With regard to claim 18, igive.com discloses the method step of providing a report having tax related information, the report including the amount of charitable donation and the amount that is tax deductible. (SEE igive.com page # 10 "** You choose the cause that receives your donation. We provide you with information supplied by the cause as to the tax deductibility of the donations made to that cause")

With regard to claim 19, igive.com discloses the method step of e-mailing the report to the donor (SEE igive.com page #2 "join for free with your e-mail address" and one is motivated to use e-mail because it's the low coat way to send reports.)

With regard to claim 42, igive.com discloses the method step of providing one or more suggestions on the amount of donation (igive.com was found above in claim 1 to read on this limitation).

With regard to claim 46, igive.com provides a method for soliciting charitable donation, the method comprising the steps of:

- hosting a website having one or more catalogs of items for purchase by online

shoppers (igive.com was found above in claims 1-19 to read on these limitations);

- providing one or more suggestions on the amount of a donation to a charitable cause, the suggestions being based on the order from the online shopper (an order is implicit) and intended to encourage and motivate a shopper to make a donation (igive.com and Ziarno were found above in claims 1-19 to read on these limitations). (Applicant's insertion of the phrase "the suggestions being based on the order from the online shopper" by amendment does not change the limitations of this claim element since an order from the online shopper was already provided as context for this claim.).

2. **Claims 2 and 3 are rejected** under 35 U.S.C. 103(a) as being unpatentable over "igive.com" in view of Ziarno applied to claim 1 above, and further in view of David King, "SOLICITING VIRTUAL MONEY", Library Journal. New York: Fall 2000. pg. 39, 3 pgs teaches.

With regard to claims 2 and 3, igive.com does not illustrate the method step of displaying one or more virtual plaques honoring donors and the step of updating the virtual plaques when a donation is made.

King discloses this above feature (SEE King page 40 "The goal of **cyberplaquing**, also known as **electronic plaguing** or electronic recognition, is quite simply recognition. The concept of memorializing or honoring a special friend or benefactor of the organization has been around awhile. Naming a wing or room of a building is one form; those making more modest donations may have their names placed on an entryway wall or even individual items of furniture. **Cyberplaquing is nothing more than providing that recognition in an online environment.** Moreover, rather than just giving a name and date, with a cyberplaque, historical information about a company or a biography about the person can be provided. **Different levels of donations may earn differing levels of recognition, including perhaps pictures of donors, dedications, testimonials, and in-depth information.** Benefactors have an "online brag sheet" of sorts, which can be used to **encourage** their friends and colleagues to

match their own contributions. The University of Pennsylvania Library has done a fantastic job of honoring benefactors with cyberplaques. Currently, eight cyberplaque pages are linked from the "Individual Benefactors" pages of the Friends of the Library web site. Each cyberplaque gives background information on the benefactor-usually a short list of that persons major achievements. Information about the gift is also given, whether it was money or a rare collection. If a rare collection has been given, the collection is described in detail. If a room or building has been named in honor of the person, the room/buildings use is explained. Penn's cyberrecognition doesn't stop with individuals. Reunion classes, corporations, and foundations are also listed. For example, the class of 1968 has a cyberplaque describing the new reference center the alumni helped fund. ")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the igive.com method to clearly add the additional step of "displaying one or more virtual plaques honoring donors" as taught by King because King teaches motivation "Benefactors have an "online brag sheet" of sorts, which can be used to encourage their friends and colleagues to match their own contributions."

Response to Arguments

3. Applicant's arguments with respect to claims 1 and 46 filed March 7, 2007 have been considered but they are not persuasive.

ARGUMENT A: 'The Examiner now acknowledges that igive.com does not disclose providing any suggestions on the amount of donation. Instead, the Examiner relies on Ziano as disclosing "electronically providing suggestions of varying donation amount.'" (p. 7, ll. 22-24).

RESPONSE: The examiner did not acknowledge in the Office Action of September 7, 2007, on page 3, lines 16-127, or anywhere else in that Office Action that "igive.com does not disclose providing any suggestions on the amount of donation." It is difficult to see how that could be construed from those two lines or anywhere else in that Office Action. The two lines Applicant refers to read as follows: "Ziarno discloses electronically

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providing suggestions of varying donation amounts (Col. 24, ll. 31 – Col. 25, l. 2).". To the contrary, said Office Action, as does this Office Action, contains the following on page 2, ll. 18-21: "SEE igive.com page #2 " **What if?...**up to 12% of each purchase you made went to a worthy cause close to home'? * add your favorite cause to our list * or **choose from 12180 already listed ... Its Working!** * \$776,875.89 raised for causes. * \$278,353.36 raised for causes just this year! * View the list of checks sent to causes". This disclosure suggests donations of up to 12%. The examiner only added the Ziarno to provide greater depth to the presentation of prior art.

ARGUMENT B: "Ziarno discloses a terminal or a peripheral with a card reader through which a credit card may be read. The terminal detects the type of card and displays a recommended contribution or gift amount. Ziarno does not relate to the e-commerce environment and, therefore, does not teach or suggest receiving any order from an online shopper. As a result, the system disclosed in Ziarno is incapable of suggesting a donation amount based on an order." (p. 8, ll. 1-5).

RESPONSE: Ziarno is directly involved in ecommerce involving the electronic environment, credit cards, electronic readers of credit cards, the making of electronic payments through said credit cards, and the making of these payments for charitable donation purposes. Use of credit cards through an electronic medium to make payments does in fact suggest electronic shopping since electronic shopping already was a ubiquitous activity at the time of Applicant's invention. Further, an ordinary practitioner of the art would have found it obvious to make use of Ziarno additional disclosures concerning the types of suggestions which can be used in the solicitation of donations during an electronic shopping event. The legitimacy of this obviousness combination is further reinforced by the recent Federal Circuit ruling of *In re Khan*, which states in part:

"A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process

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and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re Kahn, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

Therefore, in this instance, the ordinary practitioner would have found the Ziarno disclosure helpful with the nature of the problem to be solved.

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 571-272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Souh, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

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or faxed to:

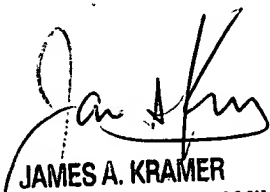
(571)273-8300 [Official communications; including After Final
communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above
USPTO web site in Alexandria, VA.

SEC

April 16, 2007

 4/16/07
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